

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIKUO SUN

Appeal No. 95-3686
Application No. 08/034,794¹

ON BRIEF

Before WINTERS, OWENS and WEIMAR, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 6. Claims 7 through 12, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

¹ Application for patent filed February 10, 1993.

Appeal No. 95-3686

Application No. 08/034,794

Appeal No. 95-3686
Application No. 08/034,794

THE INVENTION

The invention relates to a mono-axially oriented polypropylene film with sodium benzoate as an additive to reduce shrinkage. Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A mono-axially oriented polypropylene film comprising:
 - 1) polypropylene,
 - 2) sodium benzoate,

wherein the sodium benzoate ranges up to 1000 ppm.

THE REFERENCE

The reference relied on by the examiner is:

Hughes	3,540,979	Nov. 17, 1970
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THE ISSUE

In the Final Rejection (Paper No. 5), the examiner rejected claims 1 through 6 under 35 U.S.C. § 103 as unpatentable over Hughes. The examiner further rejected claims 1 through 6 under 35 U.S.C. § 103 as unpatentable "over Applicant's disclosure of prior art (page 3, SPEC), lines 15 through 25" (Final Rejection, page 2, penultimate paragraph). The latter rejection was based on a discussion of prior art references in the "BACKGROUND OF THE INVENTION" portion of

Appeal No. 95-3686
Application No. 08/034,794

applicant's specification. Based on a review of the Examiner's Answer (Paper No. 8), we find that the latter rejection has been withdrawn. This follows because, in the Answer, the examiner does not repeat or refer to a rejection of claims 1 through 6 under 35 U.S.C. § 103 as unpatentable over applicant's discussion of prior art references set forth in the specification.

Accordingly, the sole issue presented for review is whether the examiner erred in rejecting claims 1 through 6 under 35 U.S.C. § 103 as unpatentable over Hughes.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicant's Appeal Brief and Reply Brief; (3) the Final Rejection (Paper No. 5) and the Examiner's Answer (Paper No. 8); and (4) the Hughes reference cited and relied on by the examiner.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 U.S.C. § 103.

DISCUSSION

We have no doubt that a person having ordinary skill in the art could have modified the laminate of Hughes by (1) selecting sodium benzoate as a nucleating agent in one of the polypropylene films therein; (2) using "up to 1000 ppm" sodium benzoate in the polypropylene film; and (3) mono-axially orienting the laminated product. This is apparent from a review of applicant's specification and claims. However, the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

We have carefully considered the Hughes reference in its entirety, and what the reference fairly teaches to one of ordinary skill in the art. On reflection, we find that Hughes does not provide adequate guidelines which would have led a person having ordinary skill from "here to there," i.e., from the Hughes laminate to the claimed mono-axially oriented polypropylene film containing sodium benzoate "wherein the sodium benzoate ranges up to 1000 ppm." Nor has the examiner established, on this record, that Hughes provides adequate

Appeal No. 95-3686
Application No. 08/034,794

reason, suggestion, or motivation to arrive at the claimed subject matter. On the contrary, Hughes teaches toward an embodiment using nucleated and non-nucleated polypropylene film or using all nucleated films where the nucleating agent promotes the formation of hexagonal crystals, namely, sodium phthalate or calcium phthalate. See Hughes, column 3, line 70, through column 4, line 22.

In the specification, applicant describes the advantage of using a sodium benzoate additive in relatively small amounts (up to 1000 ppm) in mono-axially oriented polypropylene film. According to applicant, the sodium benzoate additive reduces shrinkage and "[l]ow shrinkage is a highly desirable property for such applications as woven fabrics" (specification, page 4, lines 15 through 17). The cited prior art, however, does not attribute any such advantage to small amounts of sodium benzoate in the polypropylene film. It is our judgment, therefore, that the examiner's § 103 rejection is predicated on the impermissible use of hindsight. As stated in In re Gorman, 933 F.2d 982, 987,

Appeal No. 95-3686
Application No. 08/034,794

18 USPQ2d 1885, 1888 (Fed. Cir. 1991), it is impermissible to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.

The examiner's decision is reversed.

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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ELIZABETH C. WEIMAR)	
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Appeal No. 95-3686
Application No. 08/034,794

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